

REMARKS

The present Amendment is in response to the Examiner's Office Action mailed March 1, 2006. Claims 19 and 20 are cancelled, claims 1, 17, 21, 25, 26, 29, and 33 are amended, and new claims 41 and 42 are added. Claims 1-18 and 21-42 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

I. Information Disclosure Statement

According to the Examiner, a copy of the lined-through references were not provided. Submitted herewith are copies of the lined-through references and an accompanying IDS for consideration by the Examiner.

II. Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejects claims 25, 29, and 33 under 35 U.S.C. § 112, Second Paragraph for indefiniteness on the grounds that it is unclear what "glass-like material" and "plastic-like material" mean. In response, Applicants have amended these elements in claims 25, 29, and 33. As such, the Applicants submit that claims 25, 29, and 33 are definite and request the rejection under 35 U.S.C. § 112, Second Paragraph be withdrawn.

III. PRIOR ART REJECTIONS

A. Rejection Under 35 U.S.C. §102(b)

The Examiner rejects claims 1, 17, 18, 21-24, 26-28, and 32 under 35 U.S.C. § 102(b) as being anticipated by *Gaebe* (United States Patent No. 5,684,901). Because *Gaebe* does not teach or suggest each and every element of the rejected claims, Applicants respectfully traverse this rejection in view of the following remarks.

A claim is anticipated under 35 U.S.C. § 102(a), (b), or (e) only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Further, the identical invention must be shown in as complete detail as is contained in the claim. Finally, the elements must be arranged as required by the claim. *Manual of Patent Examining Procedure* (“MPEP”) § 2131.

Regarding claim 1, the following element is recited, “an aspherical lens configured to directly contact an optical fiber....” As shown in Figure 3 of *Gaebe*, which is relied upon in the Office Action, aspherical lens 48 is not configured to directly contact an optical fiber. As such, *Gaebe* does not teach every element of claim 1 and the Applicant respectfully requests that the rejection of claim 1 be withdrawn.

Regarding claim 17, the following element is recited, “an aspherical lens comprising a plastic material....” As the Examiner admits on page 8 of the Office Action, *Gaebe* does not “specifically [state] that the spherical lens comprises a glass material or that the aspherical lens comprises a non-glass or plastic material.” Therefore, *Gaebe* does not teach each and every element of claim 17 and the Applicants respectfully request the rejection of claims 17 be withdrawn.

Claim 18 depends from claim 17 and includes each element of claim 17. Therefore, the Applicant respectfully requests that the rejection of claim 18 be withdrawn at least for the same reasons as claim 17.

Regarding the rejection of claims 21-24, independent claim 21 recites the element, “the optical medium contacting the means for aspherically focusing light.” Figure 3, relied upon in the rejection, does not show an optical medium contacting a means for aspherically focusing light. Therefore, the Applicants respectfully request the rejection of claim 21 be withdrawn. Claims 22-24 depend from claim 21 and include every element of claim 21. Therefore, the

Applicants respectfully request the rejection of claims 22-24 be withdrawn at least for the same reasons as claim 21.

Regarding the rejection of claims 26-28, independent claim 26 recites the element, “aspherically focusing the first portion of light and the second portion of light resulting in the first and second portions of light having a common focal point at a point of contact between an aspherical lens and an optical medium.” Figure 3 relied upon in the rejection does not show a point of contact between an aspherical lens and an optical medium. Therefore, the Applicants respectfully request that the rejection of claim 26 be withdrawn. Claims 27-28 depend from claim 26 and include every element of claim 26. Therefore the Applicants respectfully request the rejection of claims 27-28 be withdrawn at least for the same reasons as claim 26.

Regarding claim 32, according to the Examiner on page 6, “both the aspherical lens and the spherical lens are considered to be proximate to both the optoelectronic element and the optical medium for optical coupling to occur between the optoelectronic element and the optical medium.” As described above, for anticipation the elements must be arranged as required by the claim. MPEP § 2131. The term “proximate” means “immediately preceding or following (as in a chain of events, causes, or effect).”¹ As clearly shown in Figure 3 relied upon in the rejection lenses 32 and 48 are proximate to each other in that they immediately precede or follow each other. Therefore, the aspherical lens and the spherical lens cannot be “considered to be proximate to both the optoelectronic element and the optical medium” as alleged by the Examiner. As such, the arrangement required by claim 32 has not been set forth by *Gaebe* and the Applicants respectfully request that the rejection of claim 32 be withdrawn.

The Examiner rejects claims 1, 17, 18, 21-24, 26-28, and 32 under 35 U.S.C. § 102(e)² as being anticipated by *Blasingame et al.* (United States Patent Application Pub. 2004/0247242).

Each of claims 1, 17, 18, 21-24, 26-28, and 32 require an “aspherical lens” or an “aspherically focusing” means or act. According to the Examiner, lens 26 in *Blasingame* is an aspherical lens. This characterization is in direct contrast, however, to the teachings of *Blasingame*. Lens 26 in Figures 3 and 6 of *Blasingame* is explicitly a “half-ball lens”. See

¹ Merriam-Webster’s Collegiate Dictionary (11th ed. 2003) (emphasis added).

² Because *Blasingame* is only citable under 35 U.S.C. § 102(e) Applicants do not admit that *Blasingame* is in fact prior art to the claimed invention but reserve the right to swear behind *Blasingame* if necessary to remove it as a reference.

paras. [0017] and [0026]. A half-ball lens is clearly not an aspherical lens. A “spherical lens” is defined as “[a] lens whose surfaces form portions of spheres.”³ (Emphasis added). Thus, a half-ball lens is a spherical lens, and therefore, not an aspherical lens. As such, *Blasingame* does not teach each and every element of claims 1, 17, 18, 21-24, 26-28, and 32 and the Applicants respectfully request that the rejection of claims 1, 17, 18, 21-24, 26-28, and 32 be withdrawn.

B. Rejection Under 35 U.S.C. § 103

The Examiner rejects claims 2-4, 6, 8, 10-12, 19, 20, 29-31, and 33-37 under 35 U.S.C. § 103 as being unpatentable over *Gaebe*.

According to the applicable statute, a claimed invention is unpatentable for obviousness if the differences between it and the prior art “are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” 35 U.S.C. § 103(a) (2005); *Graham v. John Deere Co.*, 383 U.S. 1, 14 (1966); MPEP 2142. Obviousness is a legal question based on underlying factual determinations including: (1) the scope and content of the prior art, including what that prior art teaches explicitly and inherently; (2) the level of ordinary skill in the prior art; (3) the differences between the claimed invention and the prior art; and (4) objective evidence of nonobviousness. *Graham*, 383 U.S. at 17-18; *In re Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999). It is the initial burden of the PTO to demonstrate a *prima facie* case of obviousness, which requires the PTO to show that the relied upon references teach or suggest all of the limitations of the claims. MPEP 2142 (emphasis added).

According to MPEP section 2143:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added).

³ McGraw-Hill Dictionary of Scientific and Technical Terms (5th ed. 1994)

Claims 19 and 20 have been canceled. Therefore, the rejections of those claims are moot.

The Examiner relies upon the rejections under section 102 in the Office Action for the assertion that *Gaebe* discloses all of the claim limitations as set forth therein. However, as described above, *Gaebe* does not disclose each of the elements of the claims from which claims 2-4, 6, 8, 10-12, 19, 20, 29-31, and 33-37 depend. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, the Applicant respectfully requests that the rejections of claims 2-4, 6, 8, 10-12, 19, 20, 29-31, and 33-37 be withdrawn at least for the same reasons as the claims from which they depend.

The applicant notes, however, that the Examiner makes various assertions on page 9 without citing to any source of authority. Therefore, because no source of rationale has been set forth, no concrete evidence of record has been made of record for those assertions. If the Examiner is relying on the personal knowledge of the Examiner, pursuant to 37 C.F.R. 1.104(d)(2), Applicant hereby respectfully requests an Examiner affidavit that: (i) specifically identifies any and all references(s), other than those that have been specifically cited by the Examiner, upon which the obviousness rejection of claims 2-4, 11, 19, 20, 25, 29-31, and 33-37 is based; and (ii) provides complete details concerning the reasoning and analysis of the Examiner concerning those references as those references are purported to apply to the rejection of claims 2-4, 11, 19, 20, 25, 29-31, and 33-37.

If the origin of teachings and motivation set forth for the proposed combinations exists in the references then the Applicants request that this origin be set forth by the Patent Office as suggested by MPEP 2144.08 III which states, “[w]here applicable, the finding should clearly articulate which portions of the reference support any rejection. Explicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. *Dillon*, 919 F.2d at 693, 16 USPQ2d at 1901; *In re Mills*, 916 F.2d 680, 683, 16 USPQ2d 1430, 1433 (Fed. Cir. 1990). Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual findings.”

In fact, the Examiner has overlooked many advantages that the specific material requirements of the claims exhibit as described in the Applicant’s specification. For example, when used in conjunction with VCSEL types of lasers, which have a relatively low optical power

when compared to other laser sources, cost versus performance attributes can be mitigated by using a combination of glass and plastic materials as described in paragraph [0017]. *Gaebe* does not include such teachings nor relate to optimizing the comparably low optical output of VCSEL lasers. In fact, such teachings originate in the Applicant's teachings, and therefore, suggestion that such configuration is well-known or obvious can only be based on impermissible hindsight reconstruction of the Applicants' invention.

Moreover, it is well established that the mere fact that something is "well-known" cannot serve as a substitute for motivation. *See In re Sponnovle*, 160 USPQ 237, 243 (CCPA 1969) (emphasis added) ("a patentable invention, within the ambit of 35 U.S.C. §103, may result even if the invention has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use."); *also see In re Warner*, 154 USPQ 173, 177 (CCPA 1967) which establishes that the question is never simply what is old; rather, the question is the obviousness of bringing the elements claimed in combination together. Accordingly, merely asserting that plastic and glass lenses are known in the art does nothing to establish a reason why one of ordinary skill in the art would have been led to combine a glass spherical lens with a plastic aspherical lens and, thus, does not inherently establish obviousness. For these reasons, as well as those set forth above, the Applicants respectfully requests that the rejection of claims 2-4, 11, 19, 20, 25, 29-31, and 33-37 be withdrawn.

Regarding the rejections of claims 6, 8, and 10, these claims each depend from claims 1-4. Claims 1-4 are allowable at least for the reasons set forth above. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, the Applicants respectfully request that the rejection of claims 6, 8, and 10 be withdrawn at least for the same reasons as claims 1-4 set forth above.

Regarding the rejections of claim 12, this claim depends from claims 1-3 and 11. Claims 1-3 and 11 are allowable at least for the reasons set forth above. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. Therefore, the Applicants respectfully request that the rejection of claim 12 be withdrawn at least for the same reasons as claims 1-3 and 11 set forth above.

The Examiner rejects claims 2-4, 6, 8, 10-16, 19, 20, 25, 29-31, and 33-40 under 35 U.S.C. § 103 as being unpatentable over *Blasingame*.

Blasingame qualifies as prior art only under subsection (e) of 35 U.S.C § 102. According to 35 U.S.C. § 103(c)(1), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” (Emphasis added). Application serial number 10/456,123 to *Blasingame* and the present application serial number 10/612,660 were, at the time of the invention of Application 10/612,660 was made, owned by Finisar Corporation. As set forth in MPEP 706.02(I)(2)(II), this statement alone is sufficient evidence to disqualify *Blasingame* from being used in a rejection under 35 U.S.C. 103(a) against the claims of this application. Therefore, the Applicants respectfully request that the rejection of claims 2-4, 6, 8, 10-16, 19, 20, 25, 29-31, and 33-40 be withdrawn.

The Examiner rejects claims 5, 7, and 9 under 35 U.S.C. § 103 as being unpatentable over *Gaebe* in view of *Melles Griot* (“The Practical Application of light”). Claims 5, 7, and 9 each depend from claims 1-4. Therefore, the Applicants respectfully request that the rejection of claims 5, 7, and 9 be withdrawn at least for the same reasons as claims 1-4 set forth above.

IV. NEW CLAIMS

New claims 41 and 42 have been added and are allowable over the references of record.

CONCLUSION

In view of the foregoing, Applicants believe the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 1 day of August, 2006.

Respectfully submitted,

/David A. Jones/

DAVID A. JONES
Registration No. 50,004
Attorney for Applicant
Customer No. 022913
Telephone: (801) 533-9800

W:\15436\441.3\ML0000003488V001.doc